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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,531	09/18/2000	Richard Wilson	36.P283	4683
5514	7590	08/16/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				ZHEN, LI B
		ART UNIT		PAPER NUMBER
		2194		

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/664,531	WILSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Li B. Zhen	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 June 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18,22-55 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18,22-55 and 57 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date: _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |



## DETAILED ACTION

1. Claims 1 – 18, 22 – 55 and 57 are pending in the application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 54, 55 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. Claim 54 recites the limitation "the first interface" in line 23. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 55 and 57 are apparatus claims that depend on a method independent claim. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 55 and 57 are rejected under 35 U.S.C. 101 because the claims are directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only (Ex parte Lyell).

8. Claims 1 – 18 and 22 – 54 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.
9. Claims 1 – 18 and 22 – 54 are directed to method steps which can be practiced mentally in conjunction with pen and paper, therefore they are directed to non-statutory subject matter. Specifically, as claimed, it is uncertain what performs each of the claimed method steps. Moreover, each of the claimed steps, *inter alia*, receiving, selecting, executing, loading and establishing, can be practiced mentally in conjunctions with pen and paper. The claimed steps do not define a machine or computer implemented process [see MPEP 2106]. Therefore, the claimed invention is directed to non-statutory subject matter. (The examiner suggests applicant to change “method” to “computer implemented method” in the preamble to overcome the outstanding 35 U.S.C. 101 rejection).

#### ***Claim Objections***

10. **Claims 55 and 57 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.**

Claims 55 and 57 are improper dependent claims because these claims recite a system and product claim that are multiple dependent on any of method claims 1 to 20

or 22 to 54. Although MPEP § 608.01(n) states that the fact the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper, it also states that if it is conceivable that the product claim can be infringed without infringing the base method claim then the product claim would be an improper dependent claim.

Claims 1 and 54 recites a method of providing a virtual device container to virtually extend the functionality of a network device on a network for supporting a plurality of functional application modules and the method includes performing specific steps. However, claim 55 merely defines a computing device, program memory for storing the executable steps of any of claims 1 to 20 or 22 to 54, and a processor for executing the process steps stored in the program memory. Examiner notes that claim 55 does not require any steps to be executed, but just a computing device that stores the executable steps of any of claims 1 to 20 or 22 to 54 and the computing device has a processor capable of executing the steps of any of claims 1 to 20 or 22 to 54. Therefore, any computing device that has program code for performing the executable steps of any of the claims 1 to 20 or 22 to 54 stored in its memory would infringe on dependent claim 55 but it won't infringe on any of the base method claims because the computing device will not infringe the method claims until it execute the program code to perform the steps of any of the claims 1 to 20 or 22 to 54.

Similarly, claim 57 recites a computer-readable medium that stores the computer executable process steps to perform a method according to any of claims 1 to 20 or 22 to 54. Again, examiner notes that claim 57 does not require any steps to be executed,

but just a computing-readable medium that stores the executable steps of any of claims 1 to 20 or 22 to 54. In this case, any type of computing-readable medium (i.e. hard drive, CD-ROM, or floppy disk) that stores the executable steps of any of claims 1 to 20 or 22 to 54 would infringe on dependent claim 57 but it won't infringe on any of the base method claims because the computer-readable medium will not infringe the method claims until the program code stored on the computer-readable medium is read by a computing device and executed by a processor to perform the steps of any of the claims 1 to 20 or 22 to 54.

Since it is conceivable that the product and system claims 55 and 57 can be infringed without infringing any of the base method claims then the product and system claims are improper dependent claims because they do not particularly point out and distinctly claim subject matter of invention.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li B. Zhen whose telephone number is (571) 272-3768. The examiner can normally be reached on Mon - Fri, 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Li B. Zhen  
Examiner  
Art Unit 2194

Ibz  
August 9, 2005

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